Remarks:

Prior to entry of the present amendment, claims 1-16 remained pending in the application. Claims 1-3, 5, 7 and 16 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,421,135 to Fresk et al. ("Fresk '135"). Claim 4 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,026,258 to Fresk et al. ("Fresk '258") in view of U.S. Patent No. 6,469,795 to Beaudet et al. ("Beaudet"). Claims 5, 8 and 10-15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Fresk '258.

By this amendment, applicants have amended claims 4 and 8 to make such claims more clear. Claims 1-3, 5-7 and 9-16 remain unchanged. Reconsideration of the Examiner's rejections and allowance of the present application are respectfully requested in view of the foregoing amendments and the following remarks.

Rejection under 35 U.S.C. §102(e)

As indicated above, claims 1, 2, 3, 5, 7 and 16 stand rejected under 35 U.S.C. §102(e) as being anticipated by Fresk '135. Fresk '135 discloses a multiple-function copier configured to allow a walk-up copier user to interrupt a print job at a boundary. More particularly, Fresk '135 describes the handling of multiple print and copy jobs through the assignment of a job priority code to each job (see column 13, lines 56-67).

Claim 1 recites a method of scanning a job on a document-processing device when a print path is not available. The method includes "determining that a printer job communication channel is not available", "scanning the job", "spooling the job to a mass storage device" and "storing the job in the mass storage device until the printer job communication channel becomes available."

Fresk '135 does not disclose determining that a printer job channel is not available, and does not disclose storing the job in the mass storage device until the printer job channel becomes available, both of which are recited in claim 1. Rather, Fresk et al. proposes processing print and copy jobs based on priority of such jobs. "If the print job has higher priority than the copy job, the copy job will not be allowed to interrupt the print job and will instead be queued for later processing" (see column 13, lines 56-58). "If the copy job has higher priority than the print job, the copy processor will determine whether resources available will allow both the print job and the copy job to simultaneously run" (see column 14, lines 1-4). If the network copier does not have the resources or capability to process simultaneous print and copy jobs, the copy job may interrupt the print job at a page boundary, and the page status of the print job saved (see column 14, lines 40-46). Availability of the printer job channel is not determined, and thus is not considered in connection with storage of a printer job to a mass storage device.

The Examiner asserts that "the Print Processor disclosed by Fresk et al., Element 23 of Figure 6, is equivalent to the claimed printer job channel". Applicants respectfully disagree. In Fresk '135, the print processor is a "microprocessor" that is configured to "control functions of the image forming device" and "communicate[] with other hardware elements" (column 6, lines 33-35). In contrast, applicants identify the printer job channel as a "communication path through which jobs are sent to the print engine of a printer" (see, page 7, lines 15-17). Applicants assert, based on these descriptions, that the print processor of Fresk '135 and the printer job communication channel of Applicants' claim 1 are not equivalent, but rather are distinct.

In view of the foregoing, it should be clear that Fresk '135 does not disclose each and every element of claim 1. Claim 1 thus is allowable over Fresk '135, and the rejection of claim 1 under 35 U.S.C. §102(e) should be withdrawn. Claims 2, 3, 5 and 7 depend from claim 1, and are thus allowable for at least the same reasons as claim 1.

Claim 16 recites "determining the availability of a printer job channel" and "directing the scanned images of a job to a mass storage device when the printer job channel is not available." As noted above, Fresk '135 does not disclose determining availability of the printer job channel. Furthermore, Fresk '135 does not disclose directing the scanned images of a job to a mass storage device when the printer job channel is not available. Claim 16 thus is allowable over Fresk '135, and the rejection of claim 16 under 35 U.S.C. §102(e) should be withdrawn.

Rejection under 35 U.S.C. §103(a) over Fresk '258 in view of Beaudet

Claim 4 was rejected under 35 U.S.C. §103(a) as being unpatentable over Fresk '258 in view of Beaudet. Fresk '258 discloses a method for temporarily locking out print jobs on a network copier when a copier user is present. The method involves automatically configuring the printer and scanner for operation in copy mode in response to a copier user's interacting with the device (see, column 8, lines 36-40). Beaudet discloses a printer/copier wherein a print job may be interrupted upon input by a user.

Regarding the Examiner's proposed combination, applicants assert that the combination is improper. There is no suggestion or motivation to employ the user input device of Beaudet in the method of Fresk '258.

Even assuming that Fresk '258 could incorporate the user input feature of Beaudet (an assumption which applicants contest), the resulting combination would impermissibly render the invention of Fresk '258 unsatisfactory for its intended purpose. Fresk '258 discloses an automated method for interrupting a network print job in favor of a walk-up user's copy job. Fresk '258 notes that the object of the disclosed invention is to provide both an "efficient, economical, and easily implemented" apparatus and a method "for giving a walk-up copier user priority over network print jobs" (see, column 3, lines 20-24). To fulfill this object, Fresk '258 discloses, among other matter, "tactile sensors" to detect "when a walk-up user has placed paper in [a] document feeder or tray" (see, column 6, lines 5-9). Adding a user-input feature, to inquire whether a user wishes to proceed with a copy job, runs contrary to the automated nature of the Fresk '258 job-interruption scheme and renders redundant or useless the many automated features Fresk '258 discloses to minimize user manipulation of the copier. The Examiner's rejection of claim 4 under 35 U.S.C. §103(a) should thus be withdrawn.

Rejection under 35 U.S.C. §103(a) over Fresk '258

Claims 5, 8 and 10-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Fresk '258. As noted above, Fresk '258 discloses an automated method of interrupting a network print job in favor of a walk-up user's copy job.

It appears to applicants that the Examiner is discussing Fresk '135 (rather than Fresk '258) in this section (based on the cited language from the reference). However, it is noted that Fresk '135 is disqualified as prior art against the claimed invention pursuant to 35 U.S.C. §103(c). It is noted that Fresk '258 and the present application were, at the time the invention was mad, owned by the same person or

subject to an obligation of assignment to the same person. Rejection of claims 5, 8 and 10-15 based on Fresk '135 thus cannot be sustained. Nevertheless, applicants herein address the rejections as best understood.

Claims 5 and 8 depend from claim 1. Neither Fresk '135 nor Fresk '258 disclose or suggest determining that a printer job channel is not available, and does not disclose storing the job in the mass storage device until the printer job channel becomes available, both of which are recited in claim 1. Accordingly, claims 5 and 8 should be allowed for at least the reasons as claim 1.

Claim 10 recites a document-processing device configured to scan a first job and print a second job, the device comprising: "a copy module configured to scan a first job to produce scanned images of the first job, a mass storage device coupled with the copy module; and a printer module coupled with the copy module, the printer module having a controller configured to temporarily direct the scanned images to the mass storage device when the printer module is otherwise engaged." As noted earlier, Fresk '135 discloses a multiple-function copier and a method for operating same, based on the assignment of priority codes to print and copy jobs. Fresk '258 discloses an automated method of interrupting a network print job in favor of a walk-up user's copy job. Neither discloses "a printer module having a controller configured to temporarily direct the scanned images to the mass storage device when the printer module is otherwise engaged" as recited in claim 10 (emphasis added).

The Examiner asserts that it "would have been obvious that the print controller is directing scanned images to the mass storage device or disk." However, Fresk et al. do not disclose the manner used to determine which images are directed to the

storage device. As noted earlier, Fresk et al. assign print and copy jobs different priorities and handle the jobs according to those priorities. It is explicit in Fresk '135 that "the copy processor determines whether the copy job has a higher priority than the print job" (column 13, lines 47-49). Therefore, there is no suggestion or motivation in Fresk '135 to monitor the status of the printer module itself. Fresk '258 similarly does not disclose or suggest monitoring the status of the printer module itself.

Furthermore, even if Fresk et al. did consider monitoring the status of the print module, the proposed modification would impermissibly render the invention disclosed by Fresk '135 unsatisfactory for its intended purpose. Fresk '135 discloses a "job interrupt process for a multiple function document device" (see, column 2, lines 47-48) whereby a walk-up user can "interrupt a print job" (see, column 2, lines 62-63). Such a method requires continual monitoring of copy job input by a walk-up user, and information regarding whether a pending job is a print job or a copy job and its assigned priority code. The information needed for this method cannot be provided through monitoring the status of the print module itself, as that status information conveys nothing about the relative priority of any job that may be in progress. Such a lack of "priority information" is contrary to the nature of the Fresk '135 method.

The Examiner's rejection of claim 10 under 35 U.S.C. §103(a) should thus be withdrawn and the claim allowed. Claims 11-15 depend from claim 10 and thus are allowable for at least the same reasons as claim 10.

Conclusion

Applicants believe that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicants request that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

Walter W. Karnstein
Registration No. 35,565
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679
Attorney for Applicants

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 9, 2005.

Heidi Dutro